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OFFICE OF PETITIONS

In re Application	:
Hanada et al.	:
Application No. 09/820,757	: DECISION ON APPLICATION
Filed: March 30, 2001	: FOR PATENT TERM ADJUSTMENT
Atty Docket No. 7372/70910	:

This is a decision on the "PETITION FOR RE-DETERMINATION OF CORRECTION OF PATENT TERM ADJUSTMENT UNDER 35 U.S.C. §1.54(b)," filed July 1, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to two hundred eighty-three (283) days.

The application for patent term adjustment is GRANTED to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **three hundred forty-nine (349) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On May 26, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days. On July 1, 2004, Applicants timely¹ submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is two hundred eighty-three (283) days.

Applicants assert entitlement to a patent term adjustment of two hundred eighty-three (283) days on the basis that the PTO improperly failed to enter a Power of Attorney / Change of Correspondence Address, which resulted in the mailing of Office actions to the old law firm and address of record.

Applicants fail to state whether the patent issuing from the application is subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of zero (0) days based on an adjustment for PTO delay of sixty-three (63) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1) and thirty-eight (38) days pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. 1.703(a)(3), reduced by Applicants' delays of ninety-four (94) days and eighty-one (81) days, both pursuant to 35 U.S.C. 154(b)(2)(C)(iii) and 37 C.F.R. § 1.704(b). The PTO delay of 63 days has been reviewed and found to be correct. The adjustments of 38, 94, and 81 days are at issue.

The adjustment of 94 days has been found to be incorrect. Applicants filed a Power of Attorney and Change of Correspondence Address on January 25, 2002, prior to the mailing of the first Office action. The first Office action was mailed on August 1, 2002, and was addressed to the old address of record. As a result, applicants failed to timely receive the Office action, and did not file a response until February 3, 2003 (made timely because applicants obtained a three month extension of time, and because February 1, 2003 fell on a Saturday).

In view of the fact that the August 1, 2002 Office action was addressed to the old address of record, applicant delay in responding to that Office action should have been assessed as zero (0) days. Likewise, for the same reason, applicant delay in

¹ Applicants filed the application for patent term adjustment prior to the filing of the issue fee.

responding to the April 17, 2003 final Office action on October 6, 2003 should also have been assessed as zero (0) days.

Once applicant filed the amendment on February 3, 2003, the Office was required to mail a reply within four months. See 37 C.F.R. 1.703(a)(2). The Office did not mail an Office action to the proper law firm of record until March 15, 2004. Accordingly, PTO delay should have been assessed as two hundred eighty-six (286) days, not thirty-eight (38) days, representing the number of days in the period beginning on the day after the date that is four months after the reply was filed (June 4, 2003), and ending on the day the Office action was mailed (March 15, 2004).

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **three hundred forty-nine (349) days** (286 + 63 days of PTO delay and zero (0) days of applicant delay).

The \$200.00 fee set forth in 37 CFR 1.18(e) has been charged to Deposit Account No. 06-1135, as authorized.

The application file is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (703) 305-0272.

*Karin Ferriter
for*

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen